

REMARKS

The foregoing amendment is submitted to amend the generic confectionery composition claim represented by claim 9 and chewing gum composition claim represented by claim 14 to remove any reference to eucalyptus. The reasons in support of the present amendment are set forth below. Entry of the amendment is deemed proper and is respectfully requested.

In the Advisory Action dated May 13, 2006, Applicants' arguments were refused consideration because in view of the Examiner, the request for reconsideration did not place the application in condition for allowance on the ground that the claimed invention does not define over the prior art for the reasons of record. In support of this view, the final Office Action of November 14, 2005 stated that Applicants argue that the claimed invention does not include menthol does not exclude additional components.

In particular, claims to the application have been rejected as unpatentable over Cherukuri (U.S. Patent No. 5,009,893) on the ground that the reference discloses the combination of a flavor and the particular carboxamide set forth in the present claims. The rejection is hereby traversed and reconsideration is respectfully requested.

Applicants have previously discussed the Cherukuri reference with the

Examiner during a telephonic interview on July 14, 2005 as documented in Applicants' response of August 26, 2005. Applicants emphasized that the Cherukuri reference taught an edible composition such as a chewing gum having a unique, long lasting cooling perception which provides the user with a significantly enhanced perception of breath-freshening without bitterness. This discovery came about by the unexpected results achieved with the combination of the claimed carboxamide and menthol in specific amounts (see Cherukuri, column 2, lines 34-37). Cherukuri made it clear that the use of the carboxamide alone or menthol alone failed to achieve the cooling effect claimed in the reference (Cherukuri, column 2, lines 38-41). Thus, the reference taught that the cooling agent and menthol must be used together, and the absence of the combination is a teaching away from the fair disclosure of the reference.

Table I beginning on page 10 of Cherukuri shows two examples of a chewing gum composition conforming to the teaching of the reference. Inventive Sample 1 includes peppermint flavor oil (which contains menthol), menthol as a separate component as well as the carboxamide. Inventive Sample 2 contains the same components although menthol and the carboxamide are present in different amounts. Table III in column 11 of the reference shows three additional samples (Inventive Samples 3-5) each containing spearmint (which contains menthol) and carboxamide. Table IV has a sixth Inventive Sample containing spearmint, menthol and carboxamide. Thus, Tables I, III and IV show six samples each of which is consistent with the teaching of the reference, requiring carboxamide in combination

with menthol (separately added and/or included as part of the menthol containing flavoring agent such as spearmint).

It should be noted that each of the Examples provided in connection with Tables I, III and IV are directed to the preparation of a chewing gum composition. In each case, as previously indicated, menthol must be present with the carboxamide in accordance with the teaching of the reference invention.

It is therefore submitted that claim 14 and those claims dependent thereon (claims 16, 17 and 18) are patentable over Cherukuri because, consistent with the reference, carboxamide is required in combination with menthol. Claim 14 is directed to a chewing gum composition containing a flavor effective amount of an enhanced flavoring composition. The enhanced flavoring composition consists essentially of one or more flavoring agents, none of which contain menthol. Thus, no menthol is present from the flavoring agents employed in the enhanced flavoring composition. Furthermore, the words "consisting essentially of" is a limiting term to the extent that it does not encompass the addition of menthol to the enhanced flavoring composition. The term "consisting essentially of" generally means the stated ingredients and additional ingredients that are consistent with the making of the composition and the teachings of the claimed invention. Since menthol is excluded from the claimed composition, the term "consisting essentially of" likewise prohibits the presence of menthol.

For these reasons, the claims directed to the chewing gum composition are deemed patentable over Cherikuri.

Claims 9, 11 and 13 are directed to a confectionery composition containing essentially the same components as the chewing gum composition claims. In the telephonic interview with the Examiner referred to above, it was pointed out that Table V and particularly Sample 3 showed a confectionery composition containing cherry flavor and a cooling compound absent the presence of menthol. The Examiner expressed the view that this disclosure anticipates the present invention. Applicants disagree. Sample 3 contains no separately added menthol but does include eucalyptus oil. The major constituent of eucalyptus oil is cineole which is similar to menthol in that both components stimulate the trigeminal nerve thereby eliciting a cooling sensation. Cineole, like menthol, is an aromatic compound and can be used to give additional nasal impact. Eucalyptus oil, like peppermint oil (which contains menthol) is an essential oil that provides an independent cooling effect. Thus, while Sample 3 of Table V excludes menthol, the sample contains a flavoring system which includes a compound that behaves like menthol (i.e. provides an independent cooling effect).

In order to provide a clear line of demarcation between the present confectionery composition claims and the teaching of Cherukuri, Applicants have canceled eucalyptus from the list of flavoring agents that may be used in conjunction with the present invention. Eucalyptus was originally included as a flavoring agent

because it did not contain menthol. However, because of the similarities of eucalyptus and menthol as described above, Applicants have eliminated this flavoring agent from the scope of the present confectionery claims.

It is therefore submitted that the claims directed to the confectionery composition do not include menthol for the reasons discussed above in connection with the chewing gum composition claims. In addition, the claims do not include eucalyptus as part of the enhanced flavoring composition.

Claims 14 and 18 stand rejected as obvious over Record (U.S. Patent No. 5,372,824). The reference is stated to disclose the combination of flavor and the carboxamide in the amounts claimed for use in chewing gums. The Office Action concludes that it would have been obvious for a person of ordinary skill in the art to use any flavor in the system of Record because the choice of flavor is seen to be no more than a matter of choice and well within the skill of the art. The rejection is hereby traversed and reconsideration is respectfully requested.


The Office Action overlooks the clear teaching of the reference. The Record reference states in the "Abstract" a "mint flavored chewing gum" having a reduced bitterness including a "mint flavor agent" from which at least a portion of 1-menthol has been removed. Whatever else Record may contain in its chewing gum composition, it must contain menthol. The purpose of removing some of the 1-menthol is to deal with some of the undesirable properties of mint flavoring (column

1, lines 22-25). The mint flavored chewing gum includes a cooling agent such as a carboxamide (column 2, lines 6-10). Column 6, beginning at line 20 states that a variety of flavor agents can be used in combination with the mint flavor of the present invention. Thus, when the Office Action states that it would have been obvious for one of ordinary skill in the art to use any flavor in the Record invention, what is left unsaid is that "the any flavor" must be combined with menthol. Once again, the enhanced flavoring composition of the present invention excludes menthol and there is nothing in Record leading a person of ordinary skill in the art to use any flavor in the absence of menthol.

In view of the foregoing, Applicants submit that the present application is in condition for allowance and early passage to issue is therefore deemed proper and is respectfully requested.

It is believed that no fee is due in connection with this matter. However, if any fee is due, it should be charged to Deposit Account No. 23-0510.

Respectfully submitted,

  
Allen R. Kipnes, Esquire  
Registration No. 28,433  
Attorney for Applicant

Address All Correspondence to:  
Allen R. Kipnes, Esquire  
WATOV & KIPNES, P.C.  
P.O. Box 247  
Princeton Junction, NJ 08550  
(609) 243-0330